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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/961,223 | 09/21/2001 | leon C. Chen | EQUUS-060A | 4084 |

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EXAMINER

NGUYEN, TAN QUANG

ART UNIT PAPER NUMBER

3661

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,223

Applicant(s)

CHEN, IEON C.

Examiner

TAN Q NGUYEN

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-34, 36-41 and 43-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-34, 36-41 and 43-59 is/are rejected.
- 7) ☒ Claim(s) 60 and 61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAIL ACTION

Notice to Applicant(s)

1. This office action is responsive to the Request for Continued Examination (RCE) filed on July 21, 2004. As per request, claims 29, 32, 33, 38, 40 have been amended. Claims 35 and 42 have been canceled. Claims 43-61 have been added. Thus, claims 29-34, 36-41 and 43-61 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
3. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. As per claim 29, the phrase "the steps of converting" on line 11 has no antecedence basis since there is no recitation of the converting step previously. Appropriate correction is needed.
5. The remaining claims 30-34, 36-41 and 43-52, not specifically mentioned, are rejected for incorporating the defects from their respective parent claims by dependency.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 29-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gurne et al. (5,541,840) in view of Fieramosa et al. (6,021,366).

8. As per claim 53, Gurne et al. disclose the invention as claimed which includes handheld unit for downloading the fault codes generated from the onboard computer and generating a visual output signal representative of the status of the vehicle which is independent of resources external to the handheld unit (see at least figure 1 and column 7, lines 22-40). For example, the message "O2 sensor threshold low" as shown in column 7, line 39.

9. Gurne et al. do not explicitly disclose that the visual output signal being representative of passed/failed/inconclusive status. However, it would be obvious to one of ordinary skill in the art to realize that such message in the example of Gurne et al. can be interpreted as fail status. In addition, such visual output signal representative of passed/failed/inconclusive status are well known in the art at the time the invention was made as shown in at least figure 5, steps 128, 134, 138 and 140 of the Fieramosca et al. It would have been obvious to one of ordinary skill in the art to incorporate such visual output signal as shown in the Fieramosca into the system of Gurne et al in order to clearly let the user read the status of the component being tested.

10. Gurne et al. further disclose the communication between the master station with a remote host computer (provider) via telecommunication download links, such as modem (see column 13, line 46-59). Gurne et al. also disclose that the master station includes an on-line part catalogs for the price and ordering parts needed for the repairing (see column 14, lines 7-15). Gurne et al. do not disclose the cost of labor for

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the repair. However, such information is well known at the time the invention was made and is shown in at least figure 1 of the McGuire et al. reference. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of McGuire et al. into the system of Gurne et al. in order to provide the system with the enhanced capability of obtaining both the cost of parts and labor information from a remote computer when needed.

11. As per claims 54-57, Gurne et al. further disclose the telecommunication download link between the master station with the remote computer as shown in at least column 13, line 46 to column 14, line 14. Furthermore, McGuire et al. suggest the communication link can be a direct link or indirect link as shown in at least figure 1.

12. As per claims 58 and 59, it is noted that nothing is free when downloading information from the remote computer (provider). Therefore, it is obviously the there should be a fee charge when downloading information to the master station via the remote computer and such charging is well known in the art at the time the invention was made. For example, Snow et al. reference (U.S. Patent No. 6,434,455) discloses a vehicle component diagnostic and update system which the feature of the "payment of a fee" is associated with the downloading (see at least column 15, lines 36-39).

13. Claims 60 and 61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Remarks

14. Applicant's arguments in the Request for Continued Examination filed on July 21, 200 have been fully considered and the new ground of rejection has been set forth as above.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Tan Nguyen, whose telephone number is (703) 305-9755. The examiner can normally be reached on Monday-Thursday from 5:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black, can be reached on (703) 305-8233.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

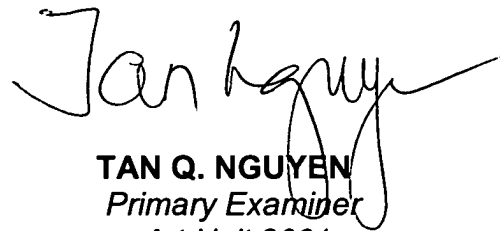
or faxed to the central official fax:

(703) 872-9306, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park V, 2451
Crystal Drive, Arlington, VA., Seventh Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

/tqn
December 18, 2003


TAN Q. NGUYEN
Primary Examiner
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